

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION No 2042430  
BY JOHNSON & JOHNSON FOR REGISTRATION  
OF A MARK IN CLASS 5**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
No 45064 BY TAKEDA CHEMICAL INDUSTRIES LIMITED**

## TRADE MARKS ACT 1994

5 **IN THE MATTER OF THE Application**  
**No 2042430 by Johnson & Johnson for**  
**registration of a mark in Class 5**

**and**

10 **IN THE MATTER OF Opposition thereto**  
**under No 45064 by Takeda Chemical**  
**Industries Limited**

15 **BACKGROUND**

On 24 October 1995 Johnson & Johnson, of New Jersey, USA, applied to register the mark  
PROSYNAP in Class 5, in respect of “pharmaceutical preparations and substances”. The  
20 application is numbered 2042430.

On 7 August 1996 Takeda Chemical Industries Ltd, of Osaka, Japan, filed notice of  
opposition to this application.

25 The grounds of opposition are, in summary:-

(i) under Section 5(2)(b), in that the mark applied for is similar to the  
opponents’ earlier trade mark (No 1234431 PROSTAP) and is proposed for  
30 registration in respect of identical or similar goods (“pharmaceutical  
preparations comprising luteinizing hormone-releasing hormones, for  
injection and/or sustained release purposes, all for human use”) and  
consequently there exists a likelihood of confusion on the part of the public,  
which includes the likelihood of association, and

35 (ii) under Section 5(4)(a), in that use of the mark applied for is liable to be  
prevented by virtue of the law of passing off.

The opponents also ask for refusal of the application under the terms of Section 3(6) and  
contend that the conduct of the applicants “and/or the nature of the mark and/or such use as  
40 may already have been made of it” provide justification for such a course.

The opponents seek an award of costs.

45 The applicants filed a counterstatement denying these grounds. On 12 August 1996 the  
applicants applied to limit the specification of goods of their application to “a pharmaceutical  
product for neuronal protection”. The applicants also seek an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 14 January 1998. At the hearing the applicants were represented by Dr Heather Lawrence, of Counsel, instructed by D Young & Co. The opponents were represented by Mr Christopher Morcom, of Her Majesty's Counsel, instructed by Forrester Ketley & Co.

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## **THE EVIDENCE**

### Opponents' evidence

10 The opponents filed Statutory Declarations by:- Paul Anthony Reacher, of Maidenhead, Berkshire; Christopher Cook, of London N11; Paul David Abel, of Southall, Middlesex; Vanessa Ann Marvin, of Guildford, Surrey, and Andrew Prentice, of Cambridge. The evidence of these last four declarants relates to a questionnaire exercise conducted by the opponents' Trade Mark Agents. I shall refer to this evidence, as necessary, later in this  
15 decision. Initially, I turn to consider the evidence of Mr Reacher.

Mr Reacher states that he is a Director of Cynamid of Great Britain Limited, (his company) which company is registered as a user of the opponents' mark PROSTAP (No 1234431). After briefly confirming the facts relating to that registration Mr Reacher goes on to state that  
20 his company has used the mark, in the United Kingdom, since 1991. Attached as exhibit PAR3 to Mr Reacher's declaration are samples of the PROSTAP mark in use. The exhibits show that the goods are sold in a yellow and blue packet upon which the mark PROSTAP SR appears prominently. The letter 'O' in PROSTAP is shown in a tear drop device. There is also a small asterisk-like device after the letter 'P'. Exhibit PAR3 also includes two promotional  
25 booklets for the opponents' goods. These show that the goods are marketed as suitable for the treatment of endometriosis and prostatic cancer. The letter 'O' in the mark PROSTAP again appears with a small degree of stylisation.

Net sales figures of PROSTAP goods, in the period 1991-1996, are given as follows:-

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<b>Year</b>	<b>£000</b>
1990/91	396
1991/92	1,398
35 1992/93	2,105
1993/94	3,238
1994/95	4,471
1995/96	5,399

40 Mr Reacher goes on to state that his company is engaged in advertising through a subsidiary company; he exhibits examples of advertisements which have appeared in The British Journal of Urology and The British Journal of Obstetrics and Gynaecology.

Mr Reacher also gives marketing expenditure figures for the years 1991 to 1996 inclusive, as  
45 follows:-

	<b>Year</b>	<b>£000</b>
	1990/91	335
	1991/92	358
5	1992/93	266
	1993/94	475
	1994/95	179
	1995/96	396

10 Finally, Mr Reacher refers to pages 370 and 371 from the November 1996 edition of the  
“Monthly Index of Medical Specialities” (“MIMS”) (which he exhibits as PAR5). It can be  
seen from these, he says, that there are a limited number of brand names with the prefix  
PROS-. Moreover, says Mr Reacher the only brand name with the suffix -AP is the  
opponents’ trade mark PROSTAP.

15 Applicants’ evidence

In response to this the applicants filed Statutory Declarations by Barbara Susan Butterworth,  
of High Wycombe, Bucks, and David John Morton Reynolds, of Oxford.

20 Ms Butterworth states that she is the Company Secretary of Janssen-Cilag Limited, (JCL) an  
English company and a subsidiary of Johnson & Johnson. It is proposed that JCL should use  
the PROSYNAP mark in the United Kingdom under licence from the trade mark owner, says  
Ms Butterworth.

25 Ms Butterworth exhibits a sample of the PROSTAP product which is currently sold by  
Lederle Laboratories under licence from Takeda Chemical Industries Limited in the  
United Kingdom. It will be noted, she says, that the packaging clearly states that the product  
is “for single use by Subcutaneous or Intramuscular Injection after reconstitution with Sterile  
30 Vehicle” and that it is a prescription only medicine (indicated by use of the “POM” symbol).

Ms Butterworth also exhibits a mock-up of the packaging which JCL is proposing to use for  
their PROSYNAP product in the United Kingdom. The proposed packaging is essentially  
white with blue lettering and blue trimming. The indication ‘8mg/16ml’ appears prominently  
35 beneath the trade mark ‘Prosynap’ within a yellow rectangle.

Finally, Ms Butterworth points out that the product to be sold under the PROSYNAP mark is  
not designed for the same clinical indications as those which PROSTAP is designed to treat.  
As it is to be administered by skilled medical practitioners in a hospital environment, the risks  
40 of product confusion would appear to be nil, she says.

I now turn to consider Dr Reynolds evidence. Dr Reynolds states he is a Consultant Clinical  
Pharmacologist and General Physician at The Oxford Radcliffe Trust, Oxford and has  
professional qualifications as follows:- MA, BMBCh, MRCP, DPhil.

45 Dr Reynolds goes on to state that he makes this Declaration in his capacity as a clinical  
pharmacologist and an expert witness, with substantial experience in the treatment of stroke

patients.

He is advised, he says, that the product to be marketed in the United Kingdom by Johnson & Johnson under the trade mark PROSYNAP is indicated for the acute treatment of stroke and is to be administered within the first six to eight hours of the stroke occurring and for up to five days thereafter. Dr Reynolds goes on to state that it is therefore an emergency treatment which will be administered in hospital emergency treatment areas or acute medical wards, by physicians experienced in the acute medical care of stroke. PROSYNAP will be marketed as a colourless solution in 20 ml colourless glass vials containing lubeluzole 0.5 mg/ml as the active ingredient. The product would normally be administered under the supervision of a qualified medical practitioner; it is not intended for over-the-counter sale, says Dr Reynolds.

Dr Reynolds further states that he is advised that PROSTAP SR is the brand name for a product marketed by Takeda through their UK Licensee, Wyeth Laboratories Limited for use by hospital oncology and urology departments for the treatment of advanced prostatic cancer. A further indication is for the treatment of endometriosis (inflammation of the womb lining) and therefore the product is also used by gynaecologists says Dr Reynolds. He is further advised that this product has two constituents, namely a vial containing a white micro capsule powder and a pre-filled syringe containing a 1 ml slightly viscous liquid vehicle for administration. The liquid is added to the powder before injection and when reconstituted it forms a cloudy suspension. In contrast to PROSYNAP, the PROSTAP SR product is for subcutaneous or intramuscular administration only. Furthermore PROSTAP SR is administered as a single injection once a month, and not as a continuous infusion over five days (as is the case with PROSYNAP).

It will be clear from the forgoing, says Dr Reynolds, that the clinical indications for the respective products are entirely different, that the route and duration of therapy are different, that the drugs will be administered in hospital or clinic environments by skilled professionals, and that the respective formulations are different. Taking this into account, says Dr Reynolds it is his considered opinion, as a potential user of the PROSYNAP product, that there is no reasonable likelihood of confusion between the two.

Dr Reynolds goes on to state that in his opinion, the name PROSYNAP suggests a connection with the synapses in the brain and is therefore apt for a product which has a neurological application. By contrast, the name PROSTAP SR recalls the connection with the prostate, the organ which is affected by prostatic cancer, he says.

With all this evidence in mind I now turn to consider the grounds of opposition.

#### 40 **THE LAW**

Section 5(2)(b) of the Act is set out below:

45 A trade mark shall not be registered if because

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

Section 5(4)(a) of the Act is as follows:

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A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered an unregistered trade mark or other sign used in the course of trade.

## DECISION

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Before me, Mr Morcom conceded that the opponents had filed no evidence which could support their ground of opposition under Section 3(6) of the Act. I therefore reject this ground of opposition. Mr Morcom also conceded that, subject to the question of colour (to which I shall return later in this decision), it was very unlikely that he could succeed under Section 5(4) if he could not do so under Section 5(2). I therefore propose to consider first the

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Mr Morcom urged me to adopt a modified version of the approach adopted by Jacob. J. In the ORIGINS case (1995 FSR 280). In that case Jacob. J. stated that Section 10:

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“..requires the Court to assume the mark of the plaintiff is used in a normal and fair manner in relation the goods for which it is registered and then to assess a likelihood of confusion in relation to the defendant uses its mark, leaving aside added matter or circumstances.”

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Jacob. J acknowledged that this was essentially the same rule as under the old law. He quoted Sir Wilfred Greene MR in Saville Perfumery v Woolworth (1939 43 RPC 147 at 161) who said:

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“the statutory protection is absolute in the sense that once a mark is shown to offend, the user of it cannot escape by showing that by something outside the mark itself he has distinguished his goods from those of the registered proprietor.”

The Origins case was an infringement action. Section 5(2) uses very similar language to Section 10(2). I therefore intend to adopt the approach set out in Origins, which adapted to the matter at hand can be expressed as follows:

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Assuming normal and fair use of the earlier trade mark in relation to any of the goods for which it is registered is there, leaving aside added matter or circumstances, a likelihood of confusion on the part of the public if the applicant uses the mark applied for normally and fairly in relation to any of the goods for which it is proposed to be registered ?

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I also bear in mind the guidance given by Jacob. J. in the TREAT case (1996 RPC 281); that it is not appropriate to elide the question of the similarity of goods with the question of whether

there is a likelihood of confusion. Thus if the respective goods are not similar the opposition under this heading must fail even if there is a likelihood of confusion.

5 In adopting this approach I reject the submissions of Dr Lawrence, the applicants' counsel, who urged me to take into account the different packaging used or proposed to be used in determining the likelihood of confusion between the marks, and substituting the actual goods in relation to which the applicants propose to use their mark for those listed in their specification for the purposes of determining whether there is similarity of goods and, if so, a likelihood of confusion.

10 The reasoning behind Dr Lawrence's proposed approach was that, whilst it was reasonable to assume the notional normal and fair use test in the absence of information about the actual goods or trading methods of the parties, once these were established in evidence the test should take these factors into account.

15 Whilst I accept that there may be circumstances where it would be appropriate to take into account evidence that an applicant uses or proposes to use a mark in a specific manner (falling within what might be considered normal and fair use of the mark) which would have the effect of increasing the likelihood confusion, I can see no justification in limiting the comparison  
20 between the respective goods under Section 5(2) so as to consider only a subset of the respective specifications. Nor do I think it proper to consider the different packaging used or proposed to be used, in deciding upon the likelihood of confusion. Such an approach would:

- 25 1. leave the proprietor of an unused mark with a broader degree of protection than a proprietor who is using his mark or has specific plans to do so;
- 30 2. result in oppositions under Section 5(2) failing (or even possibly succeeding) because of 'added matter or circumstances' which formed no part of the parties registrations or proposed registrations, and which either party could subsequently and legitimately change whilst remaining within the scope of their registrations.

35 Further, this submission appears to overlook a more obvious solution to the perceived problem. If applicants want any comparison under Section 5(2) to take account of additional distinguishing matter or a more restricted list of goods or services, they should frame (or, in the case of goods or services, restrict) their application accordingly.

40 I therefore intend to consider the applicants' goods as 'a pharmaceutical product for neuronal protection' and the opponents' goods as 'pharmaceutical preparations comprising luteinizing hormone-releasing hormones, for injection and/or sustained release purposes, all for human use'. In determining the similarity of these goods I intend to consider, insofar as they are relevant to this case, the factors identified by Jacob. J. in the TREAT case. In my view, the question of whether goods are similar is exactly the same whether it arises under Section 5 or Section 10 of the Act.

45 (A) *The respective uses of the respective goods.*

Garlands Medical Dictionary defines 'neuronal' as pertaining to neurons. The definition of

‘neuron’ is ‘any of the conducting cells of the nervous system.’ ‘Nerve cell’ is given as an alternative description. I therefore intend to construe the applicants’ goods as a pharmaceutical product relating to the protection of nerve cells. I have no evidence before me, but it appears to me to be unlikely that the opponents’ goods would be for the same or a similar specific purpose. It could be argued that all pharmaceutical products are for the same use insofar as they are all for the treatment or prevention of illness. However, I think that would be construing the question too broadly. Taking the best view I can of the matter, I do not consider that the uses of the respective goods are the same.

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*(B) The respective users of the respective goods.*

It appears to me that the ‘users’ of these goods would include doctors and medical staff, as well as their patients. The specifications are broad enough for the same medical practitioners to deal with both sets of goods. To that extent I find that the users are the same.

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*(C) The physical nature of the goods.*

The respective goods are both pharmaceuticals. To that extent they are the same. Further, the respective specifications are broad enough to cover goods in tablet or other identical physical forms.

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*(D) The respective trade channels through which the goods reach the market.*

In the absence of any relevant evidence I must answer this question from my own knowledge, which is that many pharmaceutical companies manufacture a wide range of drugs and distribute them through the same trade channels.

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*(E) The extent to which the goods are competitive. This inquiry may take into account how those in the trade classify goods.*

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I do not think that the respective goods can be regarded as competitive. There is no evidence about how the trade would classify the respective goods, but I doubt whether they would be classified together.

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There are indications in both directions, but more pointing towards similarity than away from it. I do not think the various factors should be considered in a purely quantitative fashion, but I do think that, in this case, they point towards the respective goods being similar. I so find.

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I next consider whether because of the similarity of the goods and the similarity of the marks there is a likelihood of confusion on the part of the public. Dr Lawrence for the applicants contended that I should construe ‘the public’ in line with the findings of the European Court of Justice in the case of Puma v Sabel C251/95. Dr Lawrence relied, in particular, upon the reference to the ‘average consumer’ in paragraph 23 of the Courts decision in that case. Thus, it was argued that I should only consider whether the *average consumer* of the products - the general public - would be confused, and not whether there would be confusion within the trade. In Dr Lawrence’s submission the general public would not be confused, not least because her clients’ product would only be available on prescription and be administered by

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medical professionals.

I reject that submission. It appears to me that the ECJ's reference to 'the average consumer' was no more than a comment on the public's perception of trade marks. In my view, 'the public' should be interpreted so as to mean 'the relevant public', which may include members of the trade as well as the general public. Neither of the respective specifications is limited to 'prescription only' drugs. I don't consider that the nature of the goods within the opponents' specification excludes 'across the counter' products. There is evidence that the goods the applicants intend to offer for sale under their mark will only be available on prescription. However, there is no evidence that this would be true for all goods falling within the description 'pharmaceutical products for neuronal protection', although I accept that it is more likely than not that the same would be true. In that event it appears to me that doctors and medical staff who prescribe these goods are very much a part of the relevant public. They effectively decide whether to purchase the goods by reference to the mark. I cannot therefore see any justification for removing them completely from the scope of the inquiry as to the likelihood of confusion.

As indicated above, the applicants have provided evidence from a Consultant Clinical Pharmacologist and General Physician called Dr D.J.M.Reynolds. Dr Reynolds states that, in his view, there is no reasonable likelihood of confusion between the goods sold under marks PROSTAP and PROSYNAP given their different clinical uses. In deciding what weight to give to Dr Reynolds' opinion I bear in mind that he has based his view, in part, upon:

(1) information given to him about the respective goods and their form of application which is not reflected in the specifications under consideration;

(2) the opponents' mark being PROSTAP SR rather than just PROSTAP.

In the result, I do not think it would be safe to attach too much weight to Dr Reynolds' evidence.

The opponents have also filed evidence as to the likelihood of confusion. This takes the form of a Statutory Declaration dated 10 February 1997 by Christopher Cook, who is a partner in Forrester Ketley, the opponents' UK Trade Mark Agents. Mr Cook states that on 28 January 1997 his firm sent a letter and a questionnaire to 10 doctors or pharmacists in the UK. He states that the names of these doctors and pharmacists were provided by the opponents' UK distributors. Copies of the questionnaires and letters are exhibited. The questionnaire contains seven questions. The first four ask for factual information such as name, position and relevant experience of the recipient. The fifth question asks whether the person concerned is familiar with the trade mark PROSYNAP. Given that the mark has not yet been put into use it is difficult to see the point of that question. The next question asks:

'If the answer to question five above is no but you were aware of a product under the Trade Mark PROSYNAP, would you associate the Mark with any particular product or company? If so, then please give details and the reasons for your answer.'

Question seven simply asks for 'any other comments.' Mr Cook states that three of the

persons sent a questionnaire replied. All three subsequently completed Statutory Declarations confirming their answers.

5 Of the three respondents, Paul David Abel and Vanessa Ann Marvin noted the similarity of the mark PROSYNAP to the mark PROSCAR, although the latter also noted that *'this is common in pharmaceuticals. PROS- in these is associated with 'Prostate' not a particular company.'*

10 The other respondent, Mr Andrew Prentice of the Department of Obstetrics and Gynaecology, Rosie Maternity Hospital, Cambridge stated that he was aware of PROSTAP *'as only similar name.'* Mr Prentice further states that:

*'The similarity could cause clinical confusion although Prosynap suggests a different field from Prostap.'*

15 Dr Lawrence criticised this evidence as unrepresentative. She noted that, apart from the small size of the survey, the questionnaires all appear to have been sent to persons who would be likely to be familiar with the opponents' product. Indeed, as Dr Lawrence pointed out, the names having come from the opponents' distributor, they are likely to be customers of the opponents. There is no other explanation for their selection

20 Whether that is so or not it appears to me that I should give little weight to the results of the survey. I think that the survey is open to the criticism that the questions encourage the respondents to guess about similar names when they might not otherwise have made any such connections. It is a very limited survey and the evidence it produces in support of the  
25 opponents' case comes down to the opinion of one person. In assessing the weight to give to that I also bear in mind that when Mr Prentice speaks of the likelihood of 'clinical confusion' he could not have been aware of the specific nature of the applicants' goods (no such information having been provided in the questionnaire or in the covering letter). Further, the evidence of the other two respondents tends, if anything, to support the applicants case.

30 Having decided that little weight can be given to the trade evidence, it follows that I must determine the matter primarily on the basis of my own judgement as to the likelihood of confusion. The opponents urge me to take into account that there are a limited number of trade marks in use with the prefix PROS-. The applicants dispute this. In my view the evidence  
35 does not establish that the prefix PROS- is a particularly unusual prefix for trade marks for pharmaceuticals, although the 'MIMS' index appears to show that there were no other marks in use in November 1996 which begin with PROS- and end with -AP .

40 The ECJ's decision in Puma v Sabel provides the following guidance:

45 " ..it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion 'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified.' The likelihood of confusion must therefore be appreciated globally taking into account all factors relevant to the circumstances of the case.

That global appreciation of the visual, aural or conceptual similarity of the marks in question,

must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.”

5 In this case both marks are invented words. The opponents point out that the beginnings of  
both marks (PROS-) are the same, as are the ends (-AP). The substitution of the letters ‘YN’  
in the applicants’ mark for the letter ‘T’ in the opponents’ mark, makes sufficient difference, in  
my view, as to make it unlikely that the marks will be confused if seen side by side. On the  
other hand if allowance is made for normal and fair use of the marks - where it cannot be  
10 assumed that the marks would be seen together, and which would include use of the words in  
other forms, such as in handwritten form on a doctor’s prescription - the difference between  
the marks may not be nearly so apparent. In these circumstances I think there is potential for  
visual confusion.

15 I must also consider whether there is likely to be confusion through aural use of the marks. I  
take the view that PROSYNAP is likely to be pronounced as PRO-SYN-AP, whereas  
PROSTAP is likely to be pronounced as PRO-STAP or PROST-AP. In that event I do not  
think that there is any likelihood of aural confusion.

20 Under the old law it was well established that the possibility of imperfect recollection should  
also be considered. I have no doubt that this is still appropriate. I bear in mind that both marks  
are invented words which are more likely to be confused through imperfect recollection than  
familiar dictionary words. I also bear in mind that the goods within the applicants’  
specification are unlikely to be available ‘over the counter’. However, even if this is right, it is  
possible for professional medical staff to be confused in the right circumstances.

25 I conclude that there is at least potential for confusion between the marks. However, it is clear  
from Section 5(2) of the Act (and the wording of the tenth recital to the preamble to the  
Directive) that in deciding whether there is a likelihood of confusion I should take account not  
only of the degree of similarity between the marks, but also the degree of similarity between  
30 the respective goods, and any other *relevant* circumstances.

At the risk of stating the obvious, it appears to me that there will generally be less likelihood  
of confusion where one is not only considering different marks, but also different goods.  
Further, the more specialised the goods the less likely it is that there will be confusion with  
35 other similar goods sold under similar marks. For in those circumstances, the number of  
people who use the goods will be fewer and they are also more likely to be familiar with the  
goods and trade marks.

40 The applicants’ goods are currently described as ‘a pharmaceutical product for neuronal  
protection’ which, as I have already found, could cover any drug relating to the protection of  
nerve cells anywhere in the body. By contrast, the applicants’ evidence makes it clear that the  
actual goods of interest are drugs for the acute treatment of strokes. Whilst neither is likely to  
be an ‘across the counter’ product, I consider this assumption to be a lot safer with regard to  
the latter description. I further consider the goods covered by the latter description to be more  
45 specialised than the goods that may fall within the former description.

I consider it a marginal case, but taking the best view I can of the matter I consider that there

is a likelihood of confusion if the marks are used normally and fairly on all the goods within the respective specifications. However, I further find that if the applicants limit their specification to ‘pharmaceutical products for the acute treatment of strokes’, there would then be no real tangible likelihood of confusion.

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Under the old law, it was the Registrar’s practice in these circumstances to allow the applicant a period of time within which to restrict the specification, failing which the application would be refused. I have considered whether that approach is still appropriate under the new law. I believe that it is.

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Although it is not reproduced directly in national legislation, Article 13 of EC Directive 89/104 states that:

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‘Where grounds for refusal or registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.’

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Section 39(1) of the Act states that an applicant may *at any time* restrict the goods or services covered by the application. It therefore appears to me that I should allow the applicants a period of one month to file a form TM21 restricting their specification in the manner set out above.

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As I noted earlier, Mr Morcom for the opponents conceded that, with one caveat, he had no better case under Section 5(4) than under Section 5(2). The caveat related to the colours of the packaging used or proposed to be used by the parties.

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In the light of Mr Morcom’s position, I do not think that it is necessary for me to deal with the ground of opposition under Section 5(4) of the Act, except insofar as the evidence as to the similarity (or otherwise) of the colours used or proposed to be used by the parties on the packaging for their goods could produce a more favourable result for the opponents under Section 5(4) than under Section 5(2).

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Mr Morcom initially took the position that applicants’ proposed use of the colours blue and yellow on the packaging for their goods increased the likelihood of confusion and should be taken into account in determining the position under Section 5(4). I understood him to subsequently modify that position and instead advocate that I should simply consider all normal and fair use of the applicants’ (word) mark.

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For her part, Dr Lawrence contended that the differences in the parties packaging should be regarded as assisting the applicants’ case. She urged me to take into account that, although the applicants’ proposed packaging contained elements in blue and yellow, the predominant background colour was white. Dr Lawrence also urged me to take account of the different size and shapes of the boxes within which the goods are sold (or proposed to be sold) and the different physical characteristics of the goods (the opponents’ goods being sold in powder form whereas the applicants’ goods being sold in vials).

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Section 5(4) of the Act states that:

‘A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

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a) by virtue of any rule of law (in particular the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.’

10 In my view it is clear from this that I should consider whether use of *the trade mark tendered for registration* is liable to be prevented by the law of passing off. The trade mark tendered for registration consists exclusively of a word. It does not include the colours or the shape of the packaging for the goods.

15 These features are ‘added matter’ which have no more relevance as far as the applicants’ mark is concerned in deciding the matter under Section 5(4), than is the case under Section 5(2), or would be the case with regard to the use of a defendant’s sign under Section 10(2).

20 I agree that the inquiry under Section 5(4) should take account of all the factual circumstances surrounding the use of *the opponents’ mark*, as would happen in any passing off action. The test under Section 5(4) therefore involves an inquiry as to the result of normal and fair use of the applicants’ mark in the light of the actual use and goodwill established by the opponent.

25 The words ‘*to the extent that, its use in the United Kingdom is liable to be prevented*’ may allow an applicant to escape the refusal of his application by restricting his specification so as to reflect the physical characteristics of his goods in such a way so as to reduce the likelihood of any confusion with an opponent’s goods. But where the mark applied for is simply a word, these words have no relevance to factors such as the proposed shape or colour of packaging.

30 I conclude that the opponents have no better case under Section 5(4) than under Section 5(2). Arguably it is a weaker case in that there is no evidence that the sort of confusion that could arise between the marks among medical staff would cause significant damage to the opponents’ goodwill (as opposed to the reputation of the medical staff or organisations concerned).

35 In the result, the opposition under Section 5(2) having succeeded, there is no need for me to separately decide upon the ground of opposition under Section 5(4).

40 If the applicants file a TM21 within one month of the date of this decision limiting their specification in the manner proposed above, the application may proceed to registration. If they do not do so the application will be refused.

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The applicants could have put forward such a limitation at any time after the opponents filed their opposition. They did not do so. In these circumstances it appears to me that the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £750.

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**Dated this 13 Day of March 1998.**

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**Allan James  
For the Registrar  
The Comptroller General**

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